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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/786,043      | 08/13/2001  | Ismail Kola          | DAVII21.001A        | 6828             |

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EXAMINER

ANGELL, JON E

ART UNIT PAPER NUMBER

1635

DATE MAILED: 02/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/786,043

Applicant(s)

KOLA ET AL.

Examiner

J. Eric Angell

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 101-150 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 101-150 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

Claims 101-150 are pending in the application.

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 101-105, drawn to an isolated nucleic acid molecule comprising SEQ ID No. 1, which encodes an amino acid sequence set forth in SEQ ID No. 2.
- II. Claims 106-109, drawn to an isolated nucleic acid molecule comprising SEQ ID No. 3, which encodes an amino acid sequence set forth in SEQ ID No. 4.
- III. Claims 110-113, drawn to an isolated nucleic acid molecule comprising SEQ ID No. 5 or SEQ ID No. 6, which encodes an amino acid sequence set forth in SEQ ID No. 2, which encodes an amino acid sequence set forth in SEQ ID No. 7.
- V. Claims 114-117, drawn to an isolated protein comprising SEQ ID No. 2, encoded by SEQ ID No. 1.
- VI. Claims 118-120, drawn to an isolated protein comprising SEQ ID No. 4, encoded by SEQ ID No. 3.

- VII. Claims 121-125, drawn to an isolated protein comprising SEQ ID No. 7, encoded by SEQ ID No. 5 or SEQ ID No. 6.
- VIII. Claim 126-129, 131-137 and 139-141, drawn to a method for modulating ELF5 expression and a method for treatment/prophylaxis by modulating ELF5 expression wherein the methods comprise the administration of protein.
- IX. Claims 126-128, 130-136 and 138-141 drawn to a method for modulating ELF5 expression and a method for treatment/prophylaxis by modulating ELF5 expression wherein the methods comprise the administration of nucleic.
- X. Claim 142, drawn to a pharmaceutical composition comprising ELF5, or an agent capable of modulating ELF5 expression/activity.
- XI. Claims 143, 145, 146, drawn to an antibody directed to protein.
- XII. Claims 144, 145, 146, drawn to an antibody directed to nucleic acid.
- XIII. Claim 147, drawn to a method for diagnosing or monitoring a disease.
- XIV. Claim 148, drawn to a method for detecting an agent capable of modulating the function of ELF5 wherein the method comprises monitoring expression.
- XV. Claim 149, drawn to a method for detecting an agent capable of modulating the function of ELF5 wherein the method comprises monitoring the rate of proliferation.
- XVI. Claim 150, drawn to a method for identifying an agent that binds to ELF5.

**NOTE:** Sam K. Tahmassebi confirmed by telephone on Feb. 25, 2002 that the recitation "<400>" in the claims refers to "SEQ ID No."

2. The inventions listed as Groups I-XVI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the Inventions lack the same or corresponding special technical features for the following reasons: the Inventions are not linked by a special technical feature. Several X references were cited in the International search report which demonstrate the lack of a special technical feature that unifying the Inventions (U.S. Patent 5,721, 113; Andreoli et al. (Nuc. Acids Res. 25(27), 1997p. 4287-4295; etc.).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Eric Angell whose telephone number is (703) 605-1165. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

J. Eric Angell Ph.D.  
February 26, 2002



**JEFFREY FREDMAN**  
**PRIMARY EXAMINER**